

REMARKS

As an initial note, the Applicant wishes to thank the Examiner for pointing out that Claims 13-17 were misnumbered. The claims have been renumbered accordingly. The Applicant has amended Claims 1-7, and 10-16 without prejudice as to patentability including the doctrine of equivalents. The Applicant has also canceled Claim 9 and added Claims 17-22. Original Claim 12 and Claims 13 are combined in Claim 12. Support for the amendments to Claims 1, 14, and 15, and the new Claim 17 can be found in the Application, page 1, lines 13-17 and 26-31, page 2, lines 19-22, and page 5, lines 8-12. Support for the amendments to Claim 2 and 16 can be found on page 2, lines 19-22. Support for the amendments to Claim 3 can be found on page 5, lines 8-10. Support for the amendments to Claim 4 and new Claim 22 can be found on page 3, lines 4-5, page 4, lines 6-8, and page 5, lines 12-15. Support for the amendments to Claim 5 and new Claim 18 can be found in page 2, lines 1-5, and page 5, lines 8-10. Support for the amendments to Claim 6 can be found on page 3, lines 12-14. Support for amendments to Claim 7 can be found on page 5, lines 16-19. Support for Claim 10 and new Claim 19 can be found on page 5, lines 2-5. Support for Claim 11 and new Claim 20 can be found on page 5, lines 5-7. Support for Claim 13 and new Claim 21 can be found in FIG. 2 and accompanying text. The "summary of invention" section and the "abstract" have been correspondingly amended to reflect the amendments to the independent claims. Applicant submits that these minor amendments and corrections herein are made without prejudice, were not necessary to overcome the cited references, and that no new matter has been added.

Claims 1, 4-8, 10, 12, and 15 are not Anticipated.

The Examiner rejected Claims 1, 4-10, 12, and 15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,905,774 by Tatchell et al. (hereinafter "Tatchell"). The Applicant respectfully traverses the rejection.

Tatchell describes a method and system of accessing and operating a voice message system. That is, Tatchell describes a subscriber interface operating as a Personal

Agent to "simplify, enhance and integrate . . . currently fragmented telephone services . . . using voice recognition technology. *See* col. 3, lines 25-30. Referring to col. 3, lines 31-38, "[t]he subscriber interface enables the subscriber to administer . . . options that tailor the system to the subscriber[, whereby] . . . [a]ccess and activation of telephone features are enabled and disabled by the subscriber using voice commands." Tatchell describes "integrat[ing] Calling Line ID (CLID) with . . . names identified in a personal directory and/or Name Display database to enable the subscriber [(target)] to use spoken names to instruct the various telephone features to work specifically on particular lines, e.g. 'Call Forward all calls to voice mail except for "Mom".'" *See* col. 3, lines 39-44. Tatchell describes that "a voice dialing directory (or Name Display database) can . . . be used to identify [e.g.] 'mom's' phone number(s) which would be matched against the incoming CLIDs [(of the source telephone)] to determine how to *route* [the] incoming call[]." *See* FIGS. 1 and 2(b), col. 3, lines 44-47, and col. 21, lines 21-40 (emphasis added).

Regarding independent Claim 1 (as amended), Tatchell, fails to disclose, teach, or suggest at least the following features: (1) a method of reducing telephone usage charges billed by a telephone service provider for connecting a source telephone to a target telephone; (2) billing rate plans, specifically, a source telephone number having a telephone billing rate plan providing a discounted rate for incoming calls; (3) initiating an incoming call *to* the source telephone (calling party) from a computer system (e.g. personal agent processor 27); (4) doing so having disconnected the source telephone from the computer system prior to initiating the incoming call to the source telephone; (5) connecting the source telephone with the target telephone via [through] the computer system (also featured in original claim 1); nor (6) doing so such that the source telephone service provider interprets the source telephone as a receiving telephone resulting in the source telephone service provider billing at least the source telephone number at the discount rate for incoming calls.

More specifically, rather than teach a method of reducing telephone usage charges billed by a telephone service provider for connecting a source telephone to a target telephone, Tatchell teaches a method of accessing and operating a subscriber interface for

a voice message system using speech recognition. *See* Tatchell col. 3, lines 25-47. Tatchell also fails to teach or suggest a method that can take advantage of a differential billing rate plan directed to the source telephone (Applicant's "subscriber"), a primary identified advantage described in the application. *See* Application, page 1, lines 22-23. In fact, in Tatchell, it is whom the Examiner identifies as the *target* telephone that is the "subscriber 17a-n" of the Tatchell service, thus, no description is made of directing any beneficial service to the source telephone (calling party 22).

Nor does Tatchell disclose initiating an incoming call *to* the source telephone (calling party) from a computer system (personal agent processor 27), or to do so having first disconnected the source telephone (calling party 22/24) from the computer system (itself) prior to initiating an incoming call *to* the source telephone (calling party 22/24). Tatchell either directs a call from the calling party 22/24 (source telephone) to the subscriber (target telephone), col. 10, lines 17-20, or otherwise screens or prioritizes the call, col. 20, lines 39-41. Tatchell also does not disclose connecting the source telephone with the target telephone via [through] the computer system. Instead, the personal agent 27 instructs terminating exchange (746) to *route* the call to the subscriber 17 (target). *See* FIGS. 1 and 2(b), and col. 10, lines 28-32 (emphasis added). Tatchell further does not disclose making a connection such that the source's (calling party's) telephone service provider interprets the source telephone (calling party 22) as a receiving telephone resulting in the source's (calling party's) telephone service provider billing at least the source telephone number at the discount rate for incoming calls. Note, new independent Claim 17 is also not disclosed, taught, or suggested for many of the above-described reasons. Claim 17 further has numerous additional novel and nonobvious features.

Further, regarding independent Claim 15 (as amended), for the above described reasons, Tatchell also does *not* disclose, teach, or suggest the following features: (1) instructing a computer system to connect to the *source* telephone (calling party 22) having a source telephone number; (2) such source telephone number having a telephone billing rate plan providing a discounted rate for incoming calls; (3) instructing the computer system to connect to the target telephone on a *separate* telephone line; nor (4)

instructing the computer system to bridge the source telephone (calling party 22) to the target telephone (subscriber 17a-n) such that each respective telephone service provider for the source (calling party) telephone number and the target telephone number (subscriber 17) interpret the telephone call as an incoming call resulting in at least the source's (calling party's) telephone service provider billing the source telephone number at the discounted billing rate for incoming calls.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, whereby the identical invention must be shown in as complete detail as is contained in the claim. The Examiner has not set forth each and every element of Claims 1 and 15 (as amended). Additionally, even in view of Wu (US Patent No. 6,275,575), discussed below, each and every element is not disclosed, taught or suggested. Thus, independent Claims 1 and 15, and new Claim 17 (having many of the features described above along with additional novel features), are not anticipated.

Further, the dependent Claims 4-8, 10, and 12, along with the other dependent claims have independent novelty, as well. For example, nothing is described of a method resulting in a plan provider interpreting a multi-party conference telephone call established through a computer system to be a two-way call, as featured in Claim 4 (as amended), disconnecting the calling party after two rings nor communicating the target telephone number during a callback from the computer system to the source telephone, as featured in Claim 5 (as amended), establishing a telephone connection directly through the computer system, as featured in Claim 6 (as amended), or using a voice over network Internet protocol to eliminate long distance charges associated with common carriers, as featured in Claim 7 (as amended). Further, referring to Claim 10, nothing is disclosed of a file server, separate from the incoming call server that receives target telephone data comprising the target telephone number. Still further, referring to Claim 12, nothing is described of the calling party 22 (source telephone) being given the opportunity to provide to the personal agent (computer system) a plurality of telephone numbers.

Thus, in accordance with the above discussion, the Applicant respectfully requests that the Examiner withdraw the rejection of the above described claims and allow the new claims.

Claim 14 is not Anticipated.

The Examiner rejected Claim 14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,275,575 by Wu. The Applicant respectfully traverses the rejection.

Wu describes a method and system for coordinating and initiating cross-platform telephone conferences. That is, Wu describes a method and system which allows a user of a terminal device to coordinate and initialize a multi-point telephone conference from a remote location. *See* col. 4, lines 48-51. Referring to col. 2, line 52 to col. 3, line 26, col. 10, lines 6-53, and FIGS. 1, and 8-9, the system includes a coordinating server device 102 for storing conference participant's attribute data accessible using a networked terminal device by a coordinating subscriber. The coordinating subscriber, assisted by software agents resident on the coordinating server device 102 and menu screens resident on the coordinating subscriber's networked terminal device, selects subscribers and inputs attribute data for nonsubscribers for inclusion in the telephone conference, along with proposed times and durations for a proposed telephone conference. Software agents analyze the schedule information to form invitations to invited participants, responses of which are then forwarded to the coordinating subscriber's terminal device. The coordinating subscriber then provides instructions regarding the conference. The coordinating subscriber then either initiates the conference manually or inputs scheduling information which enables a telephone conference server 106 to initiate contact with the selected participants at a pre-determined time.

Regarding Claim 14 (as amended), Wu does not disclose, teach, or suggest the following features: (1) a method for connecting a source mobile telephone having a discounted billing rate for incoming calls by a telephone service provider to a target telephone; (2) a source mobile telephone number having a lower billing rate for incoming calls than for outgoing calls such that no minutes are charged for incoming calls, only for

outgoing calls; (3) during a callback to the source mobile telephone from the computer system after disconnecting from the source mobile telephone, the source mobile telephone indicating to the computer system the telephone number of the target telephone; (4) a computer system substantially simultaneously initiating a call from the computer system to a source mobile telephone and to a target telephone on separate telephone lines; or (5) conferencing a source mobile telephone to a target telephone such that a telephone service provider for a source telephone number interprets the source mobile telephone as a receiving telephone and billing the source mobile telephone number at the billing rate for incoming calls for the conference telephone call.

Specifically, rather than teach a method for connecting a source telephone having a discounted billing rate for incoming calls by a telephone service provider to a target telephone, Wu instead describes a method and system for setting up a multi-point telephone conference between a plurality of participants. Wu was interested in a "method and system that would enable users of wireless communication devices to access cross-platform telephone conference services and to functionally interact with the control features of a cross-platform telephone conference server system from a remote location for the purpose of coordinating and initiating telephone conference meetings" that did not require "dedicated server devices and associated software costing tens of thousands of dollars." *See* col. 2, lines 26-39. No disclosure was ever made of the desire for "a system [for mobile telephones] to take advantage of rate differentials and plans that offer a lower rate for incoming calls," a problem solved by Applicant. *See* Application, page 1, lines 18-23. As such, Wu does not disclose, teach, or suggest a source mobile telephone number having a lower billing rate for incoming calls than for outgoing calls such that no minutes are charged for incoming calls, only for outgoing calls. In fact, Wu does not require an initiating call from a source mobile telephone to begin the procedural steps necessary for scheduling a telephone conference, an important feature of Applicant's claim. Even if the teleconference scheduling was initiated by the coordinator using a mobile telephone such that the coordinator's telephone could be considered a source telephone, due to the nature of Wu's teleconference scheduling methodology, Wu does

not teach or suggest that its system could terminate the call with the coordinator, callback the coordinator, and receive the target telephone number during the callback, to then initiate a call to the same coordinator's mobile telephone and to a target telephone. There is a significant inherent time delay in the Wu process. Further, Wu does not disclose, teach, or suggest establishing a telephone conference such that a telephone service provider for a source telephone number interprets the source telephone as a receiving telephone and billing the source telephone number at the billing rate for incoming calls for the conference telephone call. Inherent in the Applicant's application, is the desire for a client (source) having a source telephone to make an "immediate" phone call to a target telephone by having a computer system call the client (source) back such that this "immediate" telephone call to the target telephone number or numbers is not treated as an outgoing call, as it otherwise would be if directly dialed to the target, saving the client from having to pay a source telephone outgoing call minutes charge. Wu does not disclose anything about billing arrangements of its system.

The Examiner has not set forth each and every element of Claim 14 (as amended). Thus, independent Claim 14 is not anticipated. Additionally, even in view of Tatchell, discussed above, each and every element is not taught or suggested, for reasons similar to those discussed regarding Claims 1 and 15. Thus, in accordance with the above discussion, the Applicant respectfully requests that the Examiner withdraw the rejection of the above described claim, with the other independent and dependent claims.

Claims 2-3, 11, 13, and 16 are not Obvious.

The Examiner rejected Claims 2-3, 11, 13, and 16 as being unpatentable over Tatchell in view of Wu. The Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See* MPEP 706.02(J).

Applicant respectfully submits the Examiner has not met the first element of a *prima facie* case for obviousness. First, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Tatchell or to combine reference teachings. The Examiner has the burden of showing, as such, and has not met it here. Further, not only is there nothing explicit in either of the two references that would suggest combining them, there is also nothing implicit suggesting combining the references as the combined teachings, knowledge of one of ordinary skill in the art, and nature of the problem to be solved as a whole would not suggest doing so to those of ordinary skill in the art as required in MPEP 2143.01 and *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The problem Tatchell was trying to solve involved a need for an improved subscriber interface (operating as a personal agent) to "simplify, enhance and integrate the currently fragmented telephone services." *See* col. 3, lines 20-27. Wu's problem was the need for a "method and system that would enable users of wireless communication devices to access cross-platform telephone conference services and to functionally interact with the control features of a cross-platform telephone conference server system from a remote location for the purpose of coordinating and initiating telephone conference meetings" that did not require "dedicated server devices and associated software costing tens of thousands of dollars." *See* col. 2, lines 26-39. Due to the significant differences between the patents, there is no explicit or inherent suggestion or motivation in the references themselves to combine references. Further, the problem the Applicant was trying to solve involved a desire for "a system to take advantage of rate differentials and plans that offer a lower rate for incoming calls." *See* Application, page 1, lines 18-23. Thus, the combined teachings, knowledge of one of ordinary skill in the

art, and nature of the problem to be solved as a whole do not suggest combining the references, as the combination would not solve the Applicant's problem.

Even if the references somehow could be combined or modified, this still is not sufficient to establish a *prima facie* obviousness unless the prior art also suggests the desirability of the combination. MPEP 2143.01. As stated above, there is no suggestion as to the desirability of the combination. MPEP 2143.01 states: "the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness." The problems faced by the two patents and the Applicant are each different to a point that they are unrelated. Therefore, in accordance with the above discussion, the Examiner has not met the first element of a *prima facie* case of obviousness.

Further, and most significantly, the references when combined must teach or suggest all the claim limitations. The proposed combination of Tatchell and Wu would not result in the Applicant's invention because it would not provide a system to take advantage of rate differentials and plans that offer a lower rate for incoming calls. Instead, the combination would provide a subscriber interface operating as a personal agent that can integrate currently fragmented telephone services, one such service being the inclusion of a teleconference scheduling service.

Specifically, the combination would not teach or suggest the features separately discussed above regarding the independent claims and the dependent claims, whether original, amended, or added. Thus, the references do not teach or suggest all claim limitations. Therefore, in accordance with the above discussion, the Examiner has not met the third element of a *prima facie* case of obviousness. Correspondingly, the independent claims and all dependent claims including Claims 2-3, 11, 13, and 16, and the newly added Claims 18-20 which have additional novelty, should be deemed allowable. The Applicant respectfully requests that Examiner withdraw the rejection of the above-described claims.

CONCLUSION

In view of the amendments and remarks set forth herein, Applicants respectfully submit that the application is in condition for allowance. Accordingly, the issuance of a Notice of Allowance in due course is respectfully requested.

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Respectfully submitted,



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